#7/Reply for Reissue
9/11/99
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

McGregor, et al	Examiner: Gesesse, T.
Serial No: **08/749,721**	Group Art: 2746
Filed: **15 November 1996**	Paper No:
For: **MOBILE PHONE WITH INTERNAL ACCOUNTING**	Atty Dkt: 12765

BOX FEE-AMENDMENT
Assistant Commissioner
for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO OFFICE ACTION DATED 02/17/99

REMARKS

Applicant acknowledges and appreciates the Examiner's prompt action in moving this application to issuance. In the Office Action of February 17, 1999, the Examiner allowed all of Applicant's pending claims 1-12, 14,16 and 18-28 subject to the filing of a terminal disclaimer to overcome a double patenting rejection. As suggested by the Examiner, the assignee of Applicant, Telemac Cellular Corporation, files the accompanying Terminal Disclaimer executed by Kenin M. Spivak, the Chief Executive Officer of Telemac. The terminal disclaimer disclaims the terminal part of the statutory term of any patent granted on the instant application extending beyond the term of U.S. Patent No. 5,577,100. Copies of the assignments to Telemac Cellular Corporation of the '100 patent (Serial No. 08/381,704) recorded at

Reel 7330 and Frame 0835 and this application recorded at Reel 8373 and Frame 0460 are attached. The undersigned has reviewed the referenced assignment documents and certifies that the undersigned is empowered to sign this statement in behalf of assignee, and, that to the best of the undersigned's knowledge and belief that title is in assignee, Telemac Cellular Corporation, the entity taking this action. A check in the amount of $110.00 is enclosed pursuant to 37 CFR § 1.20(d). With the accompanying Terminal Disclaimer having been filed, Applicant submits that all of the pending claims are now in a condition for issuance.

In recognition of its obligation to keep the Examiner apprised of developments in litigation involving Applicant's U.S. Patent No. 5,577,100 ("'100 patent") which might be material to examination of the present application, Applicant is submitting the accompanying "Supplemental Information Disclosure Statement" which includes a copy of the Court's ruling in the Topp Telecom litigation that the base claim and certain dependent claims of Applicant's '100 patent are anticipated by Wittstein's U.S. Patent No. 5,631,947 ("Wittstein patent"). The Wittstein patent is already of record in the present application and was discussed at length in Applicant's last "Amendment." Because Applicant believes, among other things, that the Court's ruling misstates Applicant's position with respect to the meaning of the "complex billing algorithm" claim element of the '100 patent claims, Applicant is also submitting a copy of its pending request for

reconsideration of the Court's ruling. Applicant would be pleased to provide copies of any other documents in the voluminous record of the referenced litigation to the extent requested by the Examiner.

As the Examiner can see from comparing the Court's ruling with Applicant's last Amendment, Applicant and the Court disagree in their interpretation of the Wittstein patent. While, as the Court notes, claims 8 and 15 of the Wittstein patent refer to "plurality of charge rates," Applicant continues to believe that only two call charge rates are specifically identified in the Wittstein patent, namely a single charge rate with a minimum charge for all toll calls and a free call charge rate (see, Wittstein patent, col. 16, lns. 51-58). Applicant and the Court also disagree about whether Wittstein's "charge limit" is a "debit account" within the meaning of the '100 patent claims.

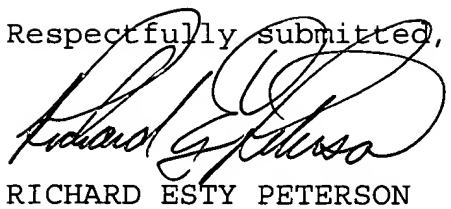
Nonetheless, regardless of whether Applicant or the Court is ultimately correct on these differences of interpretation for the Wittstein patent, Applicant submits that it is clear that *as a threshold matter* Wittstein does *not* anticipate or render obvious the claims which are pending before the Examiner in the present application. For example, all of the pending claims recite a "complex billing algorithm" defined as having "a multiple factor accounting protocol for classifying calls according to the basic categories of local calls, long distance calls, international calls

and roaming calls." Applicant submits that there is no disclosure, much less enablement, in the Wittstein patent of a "complex billing algorithm" capable of *classifying* calls "according to the basic categories of local calls, long distance calls, international calls and roaming calls." ("To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Industries, Inc. v. Guardian Industries, Corp., 75 F.3d 1558, 1565 (Fed. Cir. 1996)) Indeed, Applicant has found no mention in the Wittstein patent of *any* of the *categories* of "local", "long distance", "roaming" and "international," much less an enabling complex billing algorithm which can distinguish among *any* of them.

For these reasons, Applicant believes that the Examiner was fully correct in his Office Action determination that Applicant's pending claims are patentable over the Wittstein patent.

Applicant respectfully requests that the Terminal Disclaimer be accepted and entered, that the Information Disclosure Statement materials be considered in view of applicant's remarks and that the pending application be passed to issuance.

Respectfully submitted,



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REP:cls

Date: March 8, 1999

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